

## **REMARKS**

Claims 1-12 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Brackett '889. A rejection based on anticipation requires that the single cited reference disclose each and every feature set forth in the claims at issue. Applicants submits Brackett fails to anticipate the claims as required under 35 U.S.C. 102(b) and therefore traverse the rejection.

Claim 1 requires that the combination of container and delivery feature is adapted for user alignment and user insertion of the outlet of the delivery feature laterally into a side wall of the filter to allow placement of a substantially definable quantity of fluid at a user selected location within the smoking article. As illustrated in Figs. 5, for example, the claimed combination allows a user to select the alignment of the delivery feature with respect to the side wall and thereby the location at which the fluid is injected. The claimed combination is simple in design and does not require additional structure to align the smoking article with the delivery feature.

In contrast, Brackett '889 employs the use of a product-receiving-bore 32 into which the smoking article is placed. The product-receiving-bore 32 fixes and defines the alignment of the smoking article with respect to the needle 142 shown in Fig. 4 or needles 119, 199a shown in Fig. 5, and thereby fixes the location at which fluid is injected. The use of the product-receiving-bore 32 precludes a user from being able to align and insert the fluid delivery feature laterally into the side wall of the filter at a user defined location. Accordingly, Brackett '889 fails to disclose each and every element of claim 1 and cannot render the claim obvious.

As another example of the inappropriate citation of Brackett '889, applicants not claim 4 requires and injection needle that is a disposable unit removeably mounted on the container for one-trip use. The examiner contends that the entire apparatus of Brackett '889 can be disposed of after a single use. While this may be true, it still does

not meet the claim language which requires that the injection needle is removeably mounted onto the container. There is absolutely no teaching or suggestion in Brackett '889 that the needle 142 in Fig. 4 or the needles 119, 199a in Fig. 5 be removeably mounted. In contrast, a fair reading of the Brackett '889 illustrates that the needles are intended to be part of the overall apparatus and are intended to be used to dispense fluid multiple times. As Brackett '889 does not disclose removeably mounted needles, the reference cannot anticipate claim 4.

Still further, claim 5 requires that control of delivery of fluid is facilitated by the material from which of the container is constructed. Applicants note the examiner failed to provide any commentary as to how the cited reference discloses the elements of claim 5. For this reason alone, the rejection is improper and should be withdrawn. Applicants cannot speculate as to which elements of the reference correspond to the claimed elements of the invention. It is the responsibility and duty of the examiner to clearly set forth a prima facie case of anticipation which the applicant may then rebut. Absent a specific showing as to where Brackett '889 discloses the recited element, the rejection should be withdrawn and applicants so notified.

Claim 6 further requires that at least a portion of a wall of the container is resilient and/or pliable. The examiner makes reference to the stem 214 of dispensing valve 218 claiming that it would include a resilient member of spring. With all due respect to the examiner, the reasoning set forth in rejecting claim 6 is nonsensical. The claim refers to the wall of the container being resilient and/or pliable. The stem 214 and dispensing valve 218 of Brackett '889 do not correlate, even under any possible broadest interpretation of the plain meaning of the terms, to a wall of the container. In fact, Brackett '889 fails to provide any disclosure as to the composition of material used to construct the container 12. Accordingly, the reference also fails to anticipate claim 6 under the requirements of 35 U.S.C. 102(b).

Claim 7 requires a delivery feature including a plurality of injection needles, wherein each injection needle extends axially from one of the tobacco end or the mouth end of the smoking article to a region in the vicinity of the base of the filter. Brackett '889 does disclose the use of multiple needles in Fig. 5, but the needles extend into the side wall of the smoking article and not into one of the tobacco end or the mouth end as required in claim 7. Accordingly, the reference also fails to anticipate claim 7 under the requirements of 35 U.S.C. 102(b).

Similarly, claim 9 requires a delivery feature including an injection needle, wherein the injection needle extends axially from the tobacco end of the smoking article to a region in the vicinity of the base of said filter when inserted in the smoking article. The examiner refers to Fig. 4 of the reference in rejecting claim 9, but the needle 142 in Fig. 4 is inserted into the mouth end of the smoking article and not the tobacco end as claimed. Accordingly, the reference also fails to anticipate claim 8 under the requirements of 35 U.S.C. 102(b).

With respect to claim 20, applicants note the claim requires a plurality of disposable delivery features that are each removeably mountable to the container. The plurality of disposable delivery features are combined with a corresponding container to form the claimed kit. The examiner contends that the device of Brackett '889 is capable of being sold as a "kit", however, Brackett '889 does not disclose a plurality of disposable delivery features that correspond to a container that are removeably mountable thereto. Again, Brackett '889 does disclose multiple needles 119, 199a, but the multiple needles are not disposable and are not indicated as being removeably mountable to a container. Claim 20 is therefore believed to be patentable over the cited reference.

Claims 13, 14 and 16-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brackett '889 in view of Riccio '010. claims 13-16 and 18 further stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brackett '889 in view of Santeramo '178. Applicants submit the secondary references cited by the examiner

fail to overcome the basic deficiencies of Brackett '889 discussed above. Accordingly, depending claims 13-16, 18 and 19 are believe to be in condition for allowance for the same reasons set forth above with respect to the independent claims.

### **CONCLUSION**

In view of the above, all of the claims in this case are believed to be in condition for allowance, notice of which is respectfully urged.

Respectfully submitted,

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